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APPLICATION NUMBER 08-210,727	FILING DATE 11/22/97	FIRST NAMED APPLICANT NOVOGRAD	ATTORNEY DOCKET NO. J
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LEE, M EXAMINER

ART UNIT

PAPER NUMBER

07/17/00

DATE MAILED:

Response to Rule 312
Communication

- ☐ The petition filed _____ under 37 CFR 1.312(b) is granted. The paper has been forwarded to the examiner for consideration on the merits.

Director,
Patent Examining Group _____

- ☒ The amendment filed 1/31/00 and 3/21/00 under 37 CFR 1.312 has been considered, and has been:

- ☒ entered. *(cancellation of claims 27, 29, 56, 58-59, and 61.)*
☐ entered as directed to matters of form not affecting the scope of the invention (Order 3311).
☐ disapproved. See explanation below.
☐ entered in part. See explanation below.


Michael G Lee
Primary Examiner

PATENTS
JCN/001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Applicant : John C. Novogrod
Application No.: 08/942,957
Filed : October 2, 1997
For : SYSTEM AND METHOD FOR REQUESTING AND
DISPENSING NEGOTIABLE INSTRUMENTS
Group Art Unit : 2876
Examiner : Michael G. Lee
Issue Batch No.: D88

New York, New York 10020
March 21, 2000

Box ISSUE FEE
Assistant Commissioner
for Patents
Washington, D.C. 20231

SUBSTITUTE AMENDMENT
UNDER 37 C.F.R. § 1.312(a)

Sir:

Instead of the proposed cancellations and amendments filed in the Amendment Under 37 C.F.R. § 1.312(a) filed on January 31, 2000 in the above-identified, allowed patent application, applicant respectfully requests entry of the following claim cancellations and amendments:

In the Claims

Please cancel claims 27, 29, 56, 58-59, and 61 without prejudice.

Please amend claims 28 and 57 as follows:

28. (Twice Amended) [The portable, hand-held dispenser of claim 27, further comprising] A portable, hand-held dispenser that allows a user to request and dispense negotiable instruments, said portable, hand-held dispenser comprising:

a wireless receiver that receives dispensing information for a particular negotiable instrument from an authorizing computer;

a microprocessor that is coupled to said wireless receiver, that receives said dispensing information from said wireless receiver, and that generates printing information based upon said dispensing information;

a printer that is coupled to said microprocessor, that receives said printing information from said microprocessor, and that prints said particular negotiable instrument when said printing information is received from said microprocessor;

a battery that provides power to said microprocessor, said wireless receiver, and said printer;

a dispenser body that houses said wireless receiver, said microprocessor, said printer, and said battery, and that is a size and weight that allows said portable, hand-held dispenser to be carried in a single hand of the user; and

an input mechanism that is coupled to said microprocessor and that allows the user to submit a telephone mode command to said microprocessor, wherein said microprocessor causes said portable, hand-held dispenser to operate as a telephone and enables the user to place a voice telephone call upon said telephone mode command being received at said microprocessor.

57. (Twice Amended) [The method of claim 56, further

comprising] A method for requesting and dispensing negotiable instruments in a portable, hand-held dispenser, said method comprising:

receiving a wireless transmission of dispensing information for a particular negotiable instrument;

generating printing information based upon said dispensing information;

printing said particular negotiable instrument using said printing information;

housing said portable, hand-held dispenser in a dispenser body that is a size and weight that allows said portable, hand-held dispenser to be carried in a single hand of a user; and

operating said portable, hand-held dispenser as a telephone for placing a voice telephone call upon a telephone mode command being received from the user.

REMARKS

This application was allowed on November 5, 1999 and the issue fee was paid on February 4, 2000.

This Substitute Amendment Under 37 C.F.R. § 1.312(a) is being filed to correct a typographical error in the prior Amendment Under 37 C.F.R. § 1.312(a) filed on January 31, 2000. In that Amendment, applicant respectfully requested cancellation of claims 27, 29, 56, and 58-60 without prejudice, and entry of amendments of claims 28 and 57. Upon reviewing the present application in connection with the National Phase filing of a corresponding PCT application, a typographical error in the Amendment filed on January 31, 2000 was discovered. Particularly, the January 31, 2000 Amendment requested cancellation of claim 60 rather than requesting cancellation of claim 61. Accordingly, applicant hereby respectfully requests

that the Examiner disregard the request to cancel claim 60 in the prior Amendment Under 37 C.F.R. § 1.312(a) and instead cancel claim 61.

As set forth in the prior Amendment Under 37 C.F.R. § 1.312(a), applicant requested the claim cancellations and amendments in order to allow the present application to issue with the remaining claims and to allow the applicant to address newly raised issues of patentability as to the canceled claims in a continuation application.

More particularly, applicant requested cancellation and amendment of those claims in order to address issues of patentability that were raised by the European Patent Office while acting as the International Preliminary Examining Authority in connection with applicant's counterpart Patent Cooperation Treaty application (International Application No. PCT/US98/19681). The European Patent Office raised these issues of patentability in a Written Opinion that was issued just prior to the issuance of the Notice of Allowance and the Notice of Allowability in the present application. In particular, the Written Opinion suggests that certain aspects of the invention similar to the subject matter claimed in claims 27, 29, 56, 58-59, and 61 may not be patentable over White U.S. Patent No. 4,630,201 (hereinafter "White").

Rather than allow those claims to issue without these issues being adequately addressed, applicant expressed that he would like to cancel these claims and pursue the claims in a continuation application. Because claims 28 and 57 respectfully depend from independent claims 27 and 56, applicant also requested entry of amendments to claims 28 and 57 to incorporate all of the limitations of the independent claims. Claims 28 and 57, as amended, include limitations not shown or suggested by White. Applicant submitted that because the proposed

cancellations merely cancel allowed claims and the proposed amendments merely make dependent claims independent, no additional search or examination of the claims remaining after entry of these cancellations and amendments would be required.

Accordingly, prompt entry, pursuant to 37 C.F.R. § 1.312(a), of the proposed cancellations of claims 27, 29, 56, 58-59, and 61 and the proposed amendments of claims 28 and 57 is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Matthew T. Byrne', written over a horizontal line.

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